

DOCKET NO: 264821US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
STEFAN LAUFER, ET AL. : EXAMINER: MORRIS, P. L.
SERIAL NO: 10/524,486 :
FILED: NOVEMBER 17, 2005 : GROUP ART UNIT: 1625
FOR: 2-THIO-SUBSTITUTED :
IMIDAZOLE DERIVATIVES AND THEIR
USE IN PHARMACEUTICS

PETITION UNDER 37 CFR 1.181

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully petition from the Examiner's refusal to enter, by an Advisory Action entered March 14, 2008, the amendment under 37 CFR 1.116 filed February 26, 2008.

Statement of Facts

In the above-referenced amendment under 37 CFR 1.116 (amendment), Applicants sought to amend Claims 16 and 25. Claim 16 was sought to be amended to correct an inadvertent omission in the definition of R¹⁰. In the previous amendment filed October 1, 2007 (previous amendment), it was stated that Claim 16 was based on Claim 2. Claim 2 recited, *inter alia*, that if R³ is NR⁷COR¹⁰, R¹⁰ is R⁸. Thus, this limitation was sought to be added, as well as correcting "NR⁷COR⁸ " to --NR⁷COR¹⁰--. In the previous amendment, it was stated that Claim 25 was based on Claim 1. Claim 25 was sought to be amended to correct an inadvertent error in the definition of "Het", which is a 5- or 6-membered non-

aromatic heterocycle, as supported by, for example, original Claim 1 and page 6, line 11 of the specification.

In the Advisory Action, the Examiner refuses to enter the amendment on the grounds that:

- (1) it raises new issues that would require further consideration and/or search;
- (2) it raises the issue of new matter; and
- (3) it is not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

In a Continuation Sheet attached to the Advisory Action, the Examiner states that the amendment is non-responsive to the Final Rejection because it fails to address any of the rejections; that Applicants continue to fail to present a claim to the elected method; that Applicants have added new matter to the claims which require further consideration; and no support can be found for the newly added proviso.

Argument

Had the previous amendment been fully considered by the Examiner, it would have been appropriate to reject both Claims 16 and 25 on grounds of indefiniteness under 35 U.S.C. § 112, second paragraph; and/or failure to comply with the description requirement of 35 U.S.C. § 112, first paragraph. Then, the amendment would have been responsive to such rejection(s), thereby placing the application in better form and reducing the issues for appeal. No new issues would have been raised, since the Examiner was already informed in the previous amendment that Applicants intended Claims 16 and 25 to be based on Claims 2 and 1, respectively. Nor has any issue of new matter been raised (which the Examiner never identifies), since the corrections sought to be made in Claims 16 and 25 find bases in Claims

2 and 1, respectively. The so-called proviso can be found in original Claim 2, at page 102, lines 3-6 of the application.

The Examiner is, in effect, penalizing Applicants for the Examiner's failure to raise appropriate grounds of rejection.

Nor is it appropriate to refuse entry of the amendment on grounds that it is non-responsive to the Final Rejection when the amendment states that Applicants traverse all the rejections of record for reasons stated in the to-be-filed Appeal Brief, which was filed March 4, 2008.

Nor is it appropriate to refuse entry of the amendment on grounds that it fails to present a claim to the elected method. In a Response to Restriction Requirement filed April 3, 2007, Applicants elected rheumatoid arthritis as a specific disease, in response to the Examiner's requirement, in the restriction requirement entered March 5, 2007, to elect a specific disease. Present Claims 36 and 37 are each dependent claims that limit the inflammatory disorder of the corresponding independent claim to rheumatoid arthritis. Thus, Claims 36 and 37 are claims directed to the elected method. However, even if such claims were not present, it is not seen how failure to present such claims is ground for refusing entry of an after-Final amendment under the present circumstances.

In addition to the reasons presented above for vacating the Examiner's refusal to enter the amendment, Applicants note that an issue has been reached on the patentability of the present invention over the prior art between the Office and Applicants. Entry of the amendment will not cause the Examiner to reconsider the prior art rejection, because the amendment does not go to the merits of the rejection but rather, as discussed above, seeks to correct inadvertent errors. Thus, administrative economy will be served by entering the amendment and permitting the appeal to move forward.

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Petition under 37 CFR 1.181

Accordingly, it is respectfully requested that the amendment be entered, and that the Appeal Brief, which presumed entry of the amendment, be acted on by the Examiner.

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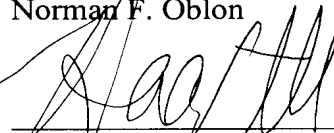
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